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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
| 09/112,020 | 07/08/98 | AOKI | K 1945-104R |

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LM02/0831

 EXAMINER

URBAN, E

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| ART UNIT | PAPER NUMBER |
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2746

*6***DATE MAILED:**

08/31/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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|------------------------------|--------------------------------------|------------------------------------|
| Office Action Summary | Application No. 09/112,020 | Applicant(s) Aoki et al. |
| | Examiner Edward F. Urban | Group Art Unit 2746 |

Responsive to communication(s) filed on Jun 6, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-26 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) 1-18 is/are allowed.

Claim(s) 19-26 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The above claims, as they are currently amended, recite a mobile communication terminal containing a satellite transceiver and a portable set disconnectable to the satellite transceiver and having a terrestrial transceiver. However, throughout the disclosure, the mobile communication terminal equipment has been defined as being mounted in a vehicle, such as an automobile and the inventive concepts of such have been directed to a mobile communication terminal equipment mounted in a vehicle. These claims, as now recited, encompass a mobile communication terminal that may be entirely portable; that is, a mobile communication terminal in which the satellite transceiver is portable. Such a feature is not supported by the original patent disclosure and therefore was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention.

Art Unit:

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit:

5. Claims 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedeman in view of Japanese document no. 4123534.

Wiedeman discloses a mobile communication terminal equipment 501 containing a satellite transceiver 520 including a satellite transmission/reception circuit for communicating with a satellite system, a terrestrial transmission/reception circuit 503 for communicating with a terrestrial system, a signal input/output for inputting and outputting signals to/from the user and a connection controller and switching means 530,531 for selectively connecting the signal input/output circuit to one of the satellite transceiver and terrestrial transceiver. Wiedeman does not disclose a portable set disconnectable from the satellite transceiver. However, the above Japanese document discloses a portable set 100,140,154 for communicating to a local area, terrestrial system when disconnected from a different local area terrestrial transceiver 301,303, but can communicate and connect with either of the local networks when connected with the local area terrestrial transceiver 301,303. Therefore, it would have been obvious to one having ordinary skill in the art to apply this portable unit communication technique of the above Japanese document to the system of Wiedeman for the purpose of allowing the phone to be more compact when only communicating with a particular local system. As to the other local area network being able to communicate with a satellite system, such would have been obvious to one of ordinary skill in the art since one would want to communicate at a much farther distance. It is considered that the above modified system contains satellite and terrestrial control means (contained in microprocessor 301) for controlling signal transmission and reception and command

Art Unit:

input means for inputting a user's command relating to the operation of the switching means as recited in claims 20-22 and 24-26. It is also considered that particular control signals are transmitted between the satellite and terrestrial control means and command input means in order for the device to properly operate and switch to the appropriate communication system.

Allowable Subject Matter

6. Claims 1-18 are allowed.

Response to Arguments

7. Applicant's arguments with respect to claims 19-26 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit:

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Urban whose telephone number is (703) 4385.

EFU

August 30, 1999


EDWARD F. URBAN
PRIMARY EXAMINER